

## **REMARKS / ARGUMENTS**

The Applicants thanks the Office for the careful consideration given to their application in the communication mailed 10/19/2007. In that communication, the Office asserted that priority to the earlier provisional application was not properly claimed, claim 9 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite, and claims 1 – 24 were rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over US 6,696,141.

Claims 1 – 2, 7 – 12, and 17 – 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (US 2,005,221) in view of Ruiz et al. (US 6,550,190). Claims 21 – 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Surlis (US 6,023,892) in view of Cohen et al. (US 2,005,221) and Ruiz et al. (US 6,550,190). Claims 3, 5, 13, and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (US 2,005,221). Although the Office did not reject claim 6, the Applicants will assume the Office intended to reject it in this group. Claims 4 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (US 2,005,221) in view of Maisotensenko et al. (US 6,581,402).

### **Priority**

The Office is correct that Applicants intend to claim priority to 60/481,191, filed 08/07/2003. The Applicants filed an Application Data Sheet with the priority claim present, page one of which is attached. If it was not claimed properly, the Applicants are also amending the Specification in this Response to add the priority claim in the first line.

### **35 USC 112**

Claim 9 has been amended in this Response to remove the indefiniteness.

### **Double Patenting**

The Applicants herewith submit a terminal disclaimer and associated fee to obviate the double patenting rejection.

### **35 USC 103(a)**

#### **Rejections Based on Ruiz et al. (US 6,550,190).**

Applicants argue that the Office has not established a prima facie case of obviousness in any of its rejections of claims based on Ruiz. The Office has not cited any teaching, suggestion, motivation, or any other reason for combining the Ruiz patent with either the Cohen or Sourlis patents to render claims 1 – 2, 7 – 12, and 17 – 24 obvious. The Ruiz patent discloses a method and apparatus that draws water inside a structure from the top of a footing. Col. 1, lines 40 – 41, Fig. 10. Ruiz uses a conduit to direct water. The Applicants' invention uses flashing to draw water to the outside of a structure. The word "flashing" never even appears in the Ruiz patent. The wicking cloth in Ruiz is not used for drawing water to the outside of a structure.

Flashing would not work in the Ruiz patent because the water collected would be dispersed within the structure instead of collected and transported through a conduit to a central receptacle. Ruiz solves a different problem than the Applicants, and is non-analogous prior art. If Ruiz is eliminated as a reference, then claims 1 – 2, 7 – 12, and 17 – 24 should be allowable.

#### **Rejections Based on Maisotsenko et al. (US 6,581,402).**

Applicants argue that the Office has not established a prima facie case of obviousness in any of its rejections of claims based on Maisotsenko. The Office has not cited any teaching, suggestion, motivation, or any other reason for combining the Maisotsenko patent with the Cohen patent to render claims 4 and 14 obvious. The Maisotsenko patent discloses a method and apparatus for making an evaporative cooler. Maisotsenko solves a different problem than the

Applicants, and is non-analogous prior art. If Maisotsenko is eliminated as a reference, then claims 4 and 14 should be allowable.

*Secondary Considerations of Non-Obviousness: Skepticism of the Experts.*

"Expressions of disbelief by experts constitute strong evidence of nonobviousness." *Environmental Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 698, 218 USPQ 865, 869 (Fed. Cir. 1983) (citing *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 483-484 (1966)). Testimony that the invention met with initial incredulity and skepticism of experts was sufficient to rebut the prima facie case of obviousness based on the prior art. *Burlington Industries Inc. v. Quigg*, 822 F.2d 1581, 3 USPQ2d 1436 (Fed. Cir. 1987). MPEP 716.05.

The Applicants herewith submit five declarations of experts citing initial skepticism in the efficacy of the present invention. The first declaration is by Lincourt, one of the inventors. Lincourt attests to the skepticism of Lolley in the publication *The Construction Specifier*, and the successful rebuttal by co-inventor Koch. The relevant pages of that publication are attached. Lincourt also attests to the skepticism of expert Lundsford in the attached letter.

The other four declarations are by independent experts who have no interest in the present patent application or its assignee. They are Michael Mahoney, William A. Sneed, Jr., David Spino, and Derek Tresnak. Accordingly, their testimony should be given great weight as secondary considerations of non-obviousness. The Applicants suggest they are sufficient to rebut a prima facie case of obviousness and that claims 1 – 24 should be allowable.

Appl. No. 10/710,845  
Amdt. dated 2/19/08  
Reply to Office action of 10/19/2007

For the foregoing reasons, the Applicants suggest that all the claims as amended are allowable, and respectfully requests that a Notice of Allowance be issued in this case.

Respectfully submitted,

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